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FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP
FOUR EMBARCADERO CENTER - SUITE 3400
SAN FRANCISCO, CA 94111-4187

EXAMINER

WATKINS III, WILLIAM P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/267,025	SHIELDS, RODNEY M.
	Examiner William P. Watkins III	Art Unit 1772
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>14 March 2002 and 27 March 2000</u> . 2a) <input checked="" type="checkbox"/> This action is FINAL . 2b) <input type="checkbox"/> This action is non-final. 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>1-5,7,9,11,12 and 22-70</u> is/are pending in the application. 4a) Of the above claim(s) _____ is/are withdrawn from consideration. 5) <input type="checkbox"/> Claim(s) _____ is/are allowed. 6) <input checked="" type="checkbox"/> Claim(s) <u>1-5, 7, 9, 11, 12 and 22-701, 5, 7, 9, 22, 24, 25, 26, 27, 28, 29, 30, 32, 34, 35-41 and 67</u> is/are rejected 7) <input type="checkbox"/> Claim(s) _____ is/are objected to. 8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement.		
Application Papers		
9) <input type="checkbox"/> The specification is objected to by the Examiner. 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action. 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received. 15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)		
1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____.		

DETAILED ACTION

1. A brief history of the case is in order. The case was filed with a Rule 47 petition on 11 March 1999 on the two year anniversary of the parent case being issued with a concurrent preliminary amendment which broadened the issued claims of the patent. The Rule 47 petition was granted and a first office action mailed 22 September 1999, which had recapture, and art rejections, as well as an objection to the reissue declaration and a rejection of claims based on that objection. A request for the original patent along with a request for an updated 1449 was also made. A new matter rejection was also made.

On 8 December 1999 a protest was filed by a third party that alleged prior public use and sale of the claimed invention as well as art and recapture issues and a concurrent petition for public use proceedings that alleged the same prior public use disclosed in the protest. On 27 March 2000 a response with a certificate of mailing dated 22 March 2000 was filed in response to the 22 September 1999 office action.

On 27 March 2000 a revocation and new power of attorney were filed by the assignee. This request was denied in a decision mailed 28 August 2000 by the Office of Petitions. On 24 July 2001 the examiner issued a new office action which held

in abeyance the previous rejections in the first office action and applicant's response to those rejections in the amendment filed 27 March 2000. The office action questioned the right of the assignee to take action in the case and made a rejection under 102(f) that Mr. Shields was not the inventor of the instant claimed subject matter. Applicant filed a response to this office action with a mailing certification of 23 January 2002. On 19 June 2002 the Petitions Office accepted the revocation and new power of attorney filed 27 March 2000. On 03 January 2002 an assignment was recorded transferring ownership of the parent 08/324,889 application of the instant reissue application to Clear Focus Imaging, Inc. On 16 May 2003 a power of attorney was filed by Clear Focus Imaging, Inc.

On 06 November 2002 a decision granting the petition to institute the public use proceeding was issued by the Office of Patent Legal Administration, which also otherwise suspended prosecution of the case. On 13 January 2003 the examiner issued a schedule for the public use proceeding. The petitioner filed testimony on 21 March 2003, applicant filed objections to the testimony on 14 April 2003, petitioner filed supplemental testimony on 05 May 2003, Applicant filed a request for cross-examination regarding petitioner's testimony on 27 May 2003. On

03 June 2003 petitioner filed a notice of withdrawal from the public use proceeding. On 18 July 2003 applicant filed a request for a stay of the public use proceeding and a time period in which to respond to petitioner's notice of withdrawal. On 19 August 2003 applicant's response to the withdrawal and a request to return all of petitioner's filed papers was received.

The instant office action will attempt to address all issues in the above history that have not been acted on, were held in abeyance, or that other wise have not been previously addressed. The rejections and objections given below are the only pending issues in the case.

2. Applicant's request for a stay and extension filed 18 July 2003 is moot in that the paper applicant wished the extension to be granted for in order to be timely filed, has already been filed and the public use proceeding is terminated as noted below.

3. Petitioner's withdrawal from the public use proceeding prevents cross examination regarding the testimony filed by the petitioner. MPEP 720.04 requires that any 325 USC 102 (b) bar due to public use, be established only by declaration evidence

that is subject to cross examination under the normal rules of evidence. As no determination regarding public use and sale can be made by the examiner, in view of lack of cross examination, the public use proceeding is held to be terminated.

This office action and future office actions are done on an ex parte basis. No further participation of the public use petitioner is allowed.

4. Regarding the protest filed 08 December 1999, the declaration evidence that alleges prior public use is identical to that considered in the public use proceeding and subject to the same limitation as noted above regarding the determination of a public use bar. The position of the examiner regarding the art and recapture issues raised in the protest is reflected in the below rejections.

5. Applicant has requested that all of the filings regarding the public use proceeding be returned to the petitioner and applicant. The examiner treats this request under the standards of a petition to expunge under 37 CFR 1.59(b) further amplified in MPEP 720.04. As the information is not deemed to be

Art Unit: 1772

confidential or of irreparable harm to any party the request is denied.

6. The supplemental reissue declaration of Gregory E. Ross filed 27 March 200 is accepted and the rejection in the first office action, based on a defective reissue declaration is withdrawn.

7. The power of attorney filed 16 May 2003 has not been accepted, as there was no paper filed establishing the right of the assignee, Clear Focus Imaging Inc., to act in the case (MPEP 1481).

8. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

There is no record of the consent of the present assignee to the filing of the reissue application.

Art Unit: 1772

9. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

10. Applicant is requested to supply a PTO Form 1449 listing the references printed on the face of the U.S. 5,609,938 parent patent in order that they may be printed on the face of the instant reissue patent, if the instant application is allowed, as required by current reissue practice.

11. The objection raised in the office action mailed 24 July 2001, under 37 CFR 1.172(a) regarding the right of the assignee to take action in the case, is withdrawn in view of applicant's arguments regarding the future improvement language in the original assignment of the 08/081,728 grandparent case as argued in the response mailed 23 January 2002.

12. The rejection under 35 USC 102(f) in the second office action mailed 24 July 2001 is withdrawn. The examiner has reconsidered the logic of the rejection. In part the rejection was based on the logic that Mr. Shields has repudiated being the

inventor of the claimed subject matter because he refused to execute the instant reissue oath in view of allegations that others invented the claimed subject matter. A close rereading of the facts relied upon in the rejection reveal that even if the hearsay statements regarding what Mr. Shields said are true, they indicate that he only refused to sign the reissue declaration in an attempt to gather information from the assignee. There is no indication that Mr. Shields repudiated being the inventor in the 08/081,728 or 08/324,889 applications where he did sign a declaration that he was the inventor. Absent such evidence and absent undisputed declaration evidence of invention by others or disputed declaration evidence that has been subject to cross examination by applicant, there is no basis to make a rejection under 35 USC 102(f). The examiner notes that applicant disputes the declaration evidence of invention by others in the response mailed 23 January 2002.

13. Claims 1-5, 7, 9, 11-12, 22-70 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. U.S.*, 221 USPQ 289,295 (Fed. Cir. 1984): "The recapture rule

Art Unit: 1772

bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application".

The examiner has carefully examined the prosecution of the parent case. The limitation of a vision panel with a liner attached with a pressure sensitive adhesive means and the limitation of a non perforated backing layer were both added by applicant late in the prosecution of the parent case to overcome the applied art rejection. Also all claims were specifically limited to having the reflective coating and opaque coating on the same side of the transparent panel, opposite the adhesive layer, as this was the only configuration supported by Figures 6A and 6C which were in turn the only embodiment that supported a nonperforated backing layer behind a perforated protective liner. The examiner notes that all method claims were canceled in the parent case. All of the instant claims do not recite a pressure sensitive adhesive means, while claims 1, 3-5, 7, 9, 11-12, 22-67, and 69-70 do not recite a non perforated backing layer, while claims 22-42 have the reflective and opaque coatings on different sides of the transparent panel. The instant method claims 22-31, 43-49 and 62-66 also appear to be at least a broad in terms of a simultaneous perforation step

as claims 64 and 66 of the '889 parent case which were canceled before allowance of the case. The absence of the above noted limitations in the instant claims as well as the lack of narrowing in the new method claims causes the instant claims to be either broader or at least as broad, regarding limitations material to overcoming the prior art rejections in the parent case, as the claims in the parent U.S. 5,609,938 patent. The instant claims thus involve recapture and are improper.

14. Applicant's arguments filed 27 March 2000 regarding recapture have been fully considered but they are not persuasive.

Applicant argues that there is an exception to the recapture doctrine based on the patent office making a mistake. Applicant bases this on a 1868 Supreme Court case. The position of the examiner is that current law is governed by *In re Clement*, 45 USPQ2d 1161 at 1166 (CAFC 1997), which states that "we do not address whether the reissue claims in this case are broader than the canceled claims in a manner directly related to the alleged error supporting reissue because we see no dispositive significance in this inquiry." Thus the examiner gives little weight to applicant's argument that the recapture

rejection should be considered in light of the alleged error by applicant that was caused by the USPTO.

Further the examiner does not agree with applicant's basic argument that the Office made an error when it cited Hill '609 for having a panel with through perforations. Applicant argues that Hill '609 has no disclosure of a perforated panel with holes that allow through viewing. This is not true; col. 13, lines 38-50 clearly teaches that the silhouette pattern may be formed by sheets which have holes where the holes function as the transparent areas in the silhouette pattern and that these sheets may be attached to or independent of other sheets or films. Thus the sheets may form a panel with through perforations. That most of the rest of the reference is not directed to this disclosure or that there are no drawings showing this disclosure or that Hill sold different products than this embodiment or that Hill's British attorney argued different support for a perforated vision panel than this passage, are all irrelevant to what this passage discloses to one of ordinary skill in the art. Regarding the decision of the British Patent Office, it of course is at most only advisory to determinations of U.S. law by this Office. Given this, a close reading of the document finds in section 41, regarding claim 132

that the original British specification does support a perforated membrane being a vision panel with an applied design. This is contrary to applicant's argument that Hill nowhere supports this structure.

15. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is not clear where this Markush group is supported in the original specification.

16. The rejection of claims 2 and 3 for new matter given in the first office action is withdrawn in view of applicant's amendments to these claims filed 27 March 2000.

17. Claims 1, 2-5, 7, 9, and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear where there is antecedent basis for "said transparent panel" in amended claim 1.

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. Claims 1, 5, 7, 9, 22, 24, 25, 26, 27, 28, 29, 30, 32, 34, 35-41 and 67 are rejected under 35 U.S.C. § 103 as being unpatentable over Hill (U.S. 4,673,609)

Hill teaches the basic concept of a panel which has an image that can be seen from the first side without an observer on the first side seeing the second side, with an observer on the second side being able to see through the panel to the first side (Figure 26(2), column 20, lines 30-35). The image may be reflective with an opaque layer on an opposite side (column 6, lines 55 through col. 7, line 10). The panel may screen U.V. light (column 3, line 1). The vision effects of the panel may be formed by use of a perforated panel with the perforations

allowing sight through the panel and the non-perforated areas blocking vision, with a reflective image pattern on one side of the panel with the perforations with the panel being formed before or after the application of the reflective image (column 13, lines 37-49, claim 15 (reexam certificate issued July 25, 1995, attached to the back of the main reference)). The panel may have an attachment adhesive and a protective release layer (claim 15, reexam cert.). The perforated sheet (silhouette pattern) and image may be between transparent protective cover sheets (column 14, lines 1-10). The sheet with the silhouette pattern may be attached to a static cling film (which maybe colored or transparent), or may be a static cling film (column 14, lines 30-40, lines 50-65). The panel may have a mirror layer (col. 14, line 65 through col. 15, line 10). Multiple panels may be used to form the reflective and opaque layers (col. 14, lines 5-15). The instant invention claims a panel with reflective and absorbing coatings on the panel with the panel with the coatings being perforated in a single step. It would have been obvious to one of ordinary skill in the art to have formed the panel which is perforated in col. 13 of the reference, where the perforations provide vision through the panel, with either reflective and opaque coatings, or reflective

Art Unit: 1772

and opaque or absorbing layers in order to enable the teachings of a perforated vision panel in column 13, because of the teaching of reflective and absorbing structures, in the rest of reference as being used to form the elements which provide the function of the vision panel. Using these material in a continuous manner with discontinuities forming the through vision areas would have been obvious given the disclosure in col. 13 to use perforations as the through vision areas instead of using these materials in a discontinuous manner and relying on space between the discontinuities to provide through vision. Perforation in one step of all layers that require through vision would also have been obvious in view of the teaching to perforate before coating of the image area. Variation in the number and position of protective and mounting layers would have been obvious to one of ordinary skill in the art given the teachings of Hill.

20. Claims 3, 4, 23, 31-33, 42, 43, 44, 45 46-48, 49, 50, 51-56, 57-66, and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill '609 as applied to claims 1, 5, 7, 9, 22, 24, 25, 26, 27, 28, 29, 30, 32, 34, 35-41 and 67 above, and further in view of Frey (U.S. 1,199,882).

Frey teaches in Figure 2 the use of a staggered pattern of transparent areas in a panel which functions as a silhouette pattern that allows viewing from one side through the panel and a reflected image from the other side. The instant invention claims the use of a perforated opaque sheet with an image on one side that has staggered holes and holes of specified sizes. It would have been obvious to one of ordinary skill in the art to use transparent areas or holes in the panel of Hill in a staggered pattern because Frey teaches this pattern as a design choice for transparent areas in a viewing panel with the function of the Hill panel. A staggered pattern in the flexible embodiments of Hill would inherently give tearing resistance. The Frey pattern is presumed to have the open area % and hole size range of the instant claims since it allows enough light through the panel to allow viewing through the panel from the back side as does the pattern of the instant claims.

21. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill '609 as applied to claims 1, 5, 7, 9, 22, 24, 25, 26, 27, 28, 29, 30, 32, 34, 35-41 and 67 above, and further in view of Mallik (U.S. 5,128,779) and Rosenthal (U.S. 4,034,555).

Mallik teaches the use of a discontinuous hologram that is formed with many openings that allows a three dimensional image to be seen from some angles in front of the hologram and vision through the hologram (abstract, col. 11 lines 28-30, col. 4, lines 45-60, col. 9, lines 15-30, col. 11, lines 10-20).

Rosenthal teaches the use of a lenticular lens layer over an image in order to form a three dimensional image. The instant invention claims a vision panel with a hologram and lenticular lens. It further would have been obvious to enhance the image of Hill by the use of a perforated hologram to provide a three dimensional effect for the image layer because of the teachings of Mallik. It further would have been obvious to use a lenticular lens system as an alternative to a hologram in order to form a three dimensional effect because of the teachings of Rosenthal.

22. Claims 2 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (U.S. 4,673,609) as applied to claims 1, 5, 7, 9, 22, 24, 25, 26, 27, 28, 29, 30, 32, 34, 35-41 and 67 above, and further in view of Bogner (DE 28 38 028).

Hill teaches perforated image, adhesive and liner layers which may be flexible and further printed after perforation

Art Unit: 1772

(col. 13, 30-35, 40-45). Bogner teaches applying a nonperforated backing layer to permeable fabric layer in order to allow the fabric layer to be better handled by various printing machines. The instant invention claims the use of a perforated image and liner layer with a nonperforated backing. It would have been obvious to one of ordinary skill in the art to use a nonperforated backing layer on the perforated image and liner layers of Hill in order to allow handling of the perforated combination during further printing because of the teachings of Bogner.

23. Applicant's arguments filed 27 March 2000 have been fully considered but they are not persuasive.

Applicant argues that Hill '609 has no teaching of a perforated vision panel. The response to this argument is the same as that given in the above recapture section as the fact issues are the same. Applicant also argues that the hole pattern of Frey and Hill are contradictory and would not be transferred between the references. The examiner is of the position that as they both serve the same function, one of ordinary skill the art would be able to transfer the teachings

with an expectation of success with the motivation being the substitution of equivalent structures.

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 703-308-2420. The

Art Unit: 1772

examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



WILLIAM P. WATKINS III
PRIMARY EXAMINER

WW/ww

September 21, 2003